

**REMARKS**

Reconsideration is respectfully requested of the Official Action of March 4, 2003.

A request for a one-month extension of time, together with the associated fee is filed herewith.

Applicants express appreciation for the suggestions contained in the Official Action for addressing the issues raised under 35 U.S.C. § 112 and with respect to the objection to the specification. Those suggestions have been adopted herein. It is therefore believed that the previous rejection under 35 U.S.C. § 112, as well as the objection to the specification, are rendered moot.

Claim 8 has been amended to specify four different radii and, therefore, it is submitted that the rejection under 35 U.S.C. § 102 has been rendered moot.

The rejection of Claims 8 to 14 under 35 U.S.C. § 103 in view of Japan '802, taken with *Tokutake* and optionally, *Iwasaki*, is traversed and reconsideration is respectfully requested. Applicants respectfully submit the references do not render the claimed invention *prima facie* obvious. The references relied on in the Official Action show tires with different characteristics; i.e., specific radii of curvature. None show any of the precise relationships set forth in the present claims. The Official Action takes the position that the specific values set forth in the present claims are embraced or overlap with a claimed range. However, the combination of references contain no guidelines enabling a person skilled in the art to arrive at the particular ranges claimed herein.

Claim 8 now includes the features of former Claims 11 and 13; and applicants respectfully submit that a person skilled in the art, without having the benefit of reading this application, would not have been lead to make the selections of the various relationships now defined by the claims by reading the cited references. It is clear that picking and choosing portions of the prior art, while ignoring other portions, to reassemble the components of the claimed invention is not the proper test of obviousness.

As stated in MPEP Section 2141, page 2100-2114, the following tenets must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus, the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

The cited references fail to suggest the desirability of the particular relationships set forth in the claims; nor do they suggest that those particular relationships would lead to a successful tire.

Japan 4-87802 discloses a tire said to have improved running performance, stability and desirability at high speeds. The tread is divided into three sections – SC, SM and SO – with very specific geometry as to the location of these sections and their relationship to the tread width

WT. Section SC is defined by two points P,P located apart from each other by a factor of  $0.175 \times WT$ . SM is defined by points P and Q separated apart from the tire equator by a distance  $0.4 \times WT$ . Outer regions SO are defined by points Q and O and are spaced apart from the equator by  $0.6 \times WT$ . There is no mention of the relationships now present in Claim 8 that define the separation TW, according to  $0.1 TW \leq TW, \leq 0.7 TW$ . (The Office Action refers to  $TR_1$ , whereas Claim 8 refers to  $TW_1$ ). Also, JP '802 fails to disclose that the transition area to said shoulder radii is at a distance RA from tread strip edges which is 1.5 to 14% of TW.

Neither would a person skilled in the art be lead to make all the changes needed to arrive at applicants' invention from a consideration of the second references.

*Tokutake* (US 5,117,886) discloses a tire having four radii (col. 6, lines 44, et seq.), but does not set forth the relationships expressed in Claim 8, as amended. No reason, motivation or suggestion appears in *Tokutake* which would enable a person skilled in the art to arrive at the parameters set forth in Claim 8. Nor is there any inkling as to achievement of success if such parameters were chosen. Only four specific values are mentioned in col. 5, at lines 50, et seq. by *Tokutake*. Those four values would not enable a skilled person in the art to arrive at the definitions set forth in the present claims which enable the production of successful tires.

*Iwasaki* (US 6,073,668) teaches that the curvature of the tire decreases continuously from the tire equator to the tread edges. Hence, a person skilled in the art would not be motivated to form a tire having four distinct sections, each with a constant radius.

To establish a *prima facie* obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916837 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Application No. 09/668,292  
Amendment  
Docket No. 032238.020

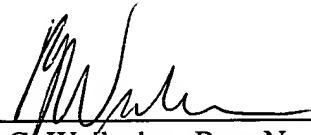
---

A statement that the modifications of the prior art to meet the claimed invention would have been "'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ 2d, 1300 (Bd. Pat. App. & Int. 1993).

For the reasons set forth above, applicants submit that the combination of references fails to establish *prima facie* obviousness. Favorable action at the Examiner's earliest convenience is respectfully requested.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

By:   
Robert G. Wellacher, Reg. No. 20,531

Suite 3100, Promenade II  
1230 Peachtree Street, N.E.  
Atlanta, Georgia 30309-3592  
Telephone: (404) 815-3593  
Facsimile: (404) 685-6893

LIT/817438.1